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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,151	02/17/2004	Jay C. Pershing	MONS:155US	1272
73905 7590 10/20/2008 SONNENSCHN NATH & ROSENTHAL LLP P.O. BOX 061080 SOUTH WACKER DRIVE STATION, SEARS TOWER CHICAGO, IL 60606				
EXAMINER KUBELIK, ANNE R				
ART UNIT		PAPER NUMBER		
1638				
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10/20/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/780,151

Applicant(s)

PERSHING ET AL.

Examiner

Anne R. Kubelik

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 1-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicant's election without traverse of Group II (claims 13-24) and the species insecticidal transgene, insecticide, and chloronicotinyl insecticide in the reply filed 13 August 2007, and species b (seed treated with a seed treatment) in the reply filed on 31 December 2007 is acknowledged. As art was found on seed without a seed treatment, the restriction between seed treatment and no seed treatment is withdrawn.
2. This application contains claims 1-12 drawn to an invention nonelected without traverse in the response filed 13 August 2007. A complete reply to the final rejection must include cancellation of nonelected claims. See MPEP § 821.01. Claims 1-12 are withdrawn from consideration as being drawn to a nonelected invention.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. The objection to claims 14-24 because of informalities is withdrawn in light of Applicant's amendment of the claims and/or arguments.
5. The rejection of claims 21 and 24 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention is withdrawn in light of Applicant's amendment of the claims.
6. The rejection of claims 13-24 under 35 U.S.C. 102(b) as being anticipated by Lambert et al (1996, Proc. Beltwide Cotton Conf. 2:931-935) is withdrawn in light of Applicant's amendment of the claims.

7. The rejection of claims 13-24 under 35 U.S.C. 103(a) as being unpatentable over Lambert et al (1996, Proc. Beltwide Cotton Conf. 2:931-935) in view of Turnblad et al (1998, US Patent 5,849,320) is withdrawn in light of Applicant's amendment of the claims.

Claim Rejections - 35 USC § 103

8. Claim 17, and all dependent claims, is not interpreted as limiting the seed to having a seed treatment, as the claim only lists possible treatment without requiring that the seed has it.

9. Claims 13-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kennedy et al (1995, J. Econ. Entomol. 88:454-460) in view of in view of Turnblad et al (1998, US Patent 5,849,320). The rejection is repeated for the reasons of record as set forth in the Office action mailed 26 March 2006. Applicant's arguments filed 22 July 2008 have been fully considered but they are not persuasive.

The claims are drawn to seed blends comprising seeds transformed with one insecticidal transgene and seeds transformed with a second insecticidal transgene, wherein both kinds of seeds are treated with a chloronicotinyl insecticidal agent.

Kennedy et al teach seed blends and expression of multiple toxins (pg 459, left column, paragraph 2). Kennedy et al do not disclose seed blends comprising seeds transformed with one insecticidal transgene and seeds transformed with a second insecticidal transgene or blends in which the seeds are treated with a chloronicotinyl insecticidal agent.

Turnblad et al teach an insecticidal coating for seeds, including cotton, in which the possible insecticides include the chloronicotinyl imidacloprid (column 4, lines 20-28, claim 9).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to modify the seed blends as taught by Kennedy et al, to combine multiple toxins and seed blends and to coat the seed blends with an insecticide as described in Turnblad et al. One of ordinary skill in the art would have been motivated to do make the blends be of seeds transformed with one insecticidal transgene and seeds transformed with a second insecticidal transgene because Kennedy teaches both seed blends and multiple toxins as important resistance management strategies; selection of multiple toxins in a single seed versus multiple toxins in the form of a different toxin in each kind of seed in a blend would be an obvious design choice. Further, the latter would allow sellers to more easily mix and match resistances according to need and market, without having to transform a second resistance gene into a plant that has a first. One of ordinary skill in the art would have been motivated to coat the seed blends with an insecticide because seed treatment is an effective method of controlling insect pests (Turnblad et al, column 2, lines 7-12), and because Kennedy et al teaches the importance of having all strategies in one convenient package (pg 459, left column, paragraph 3).

Applicant urges that neither Kennedy nor Turnblad teaches or suggests a seed blend having a transgenic seed that can serve as a refuge; the cited portion of Kennedy relates to strategies for pest management, and the “or between seed mixtures and expression of multiple toxins makes clear they are alternatives (response pg 21-22).

This is not found persuasive because Kennedy teaches both seed blends and multiple toxins as important resistance management strategies; selection of multiple toxins in a single seed versus multiple toxins in the form of a different toxin in each kind of seed in a blend would be an obvious design choice. The rejection does not say that

Applicant urges that Kennedy is purely conceptual that does not discuss any of the technical issues as to why certain strategies might work (response pg 22).

This is not found persuasive because Kennedy is not required to discuss any of the technical issues as to why certain strategies might work to make multiple toxins in the form of a different toxin in each kind of seed in a blend obvious.

Applicant urges that Kennedy predates Lambert, who says that blends of Bt and non Bt seeds sustained too much damage for the blended seed concept to be practical (response pg 22).

This is not found persuasive because the teaching of Kennedy in view of Turnblat is of a seed blend comprising seeds transformed with one insecticidal transgene and seeds transformed with a second insecticidal transgene, bit of seed blends of Bt and non Bt seeds.

Applicant urges that Turnblat does not cure the deficiencies of Kennedy, as it does not teach seed blends (response pg 23).

This is not found persuasive because Kennedy teaches seed blends, as discussed above.

Conclusion

10. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne R. Kubelik, Ph.D., whose telephone number is (571) 272-0801. The examiner can normally be reached Monday through Friday, 8:30 am - 5:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg, can be reached at (571) 272-0975.

The central fax number for official correspondence is (571) 273-8300.

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For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

October 22, 2008

/Anne R. Kubelik/

Primary Examiner, Art Unit 1638